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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,563	09/28/2001	Masaaki Nishikiori	1086.1139CIP	2578
21171 7590 08/07/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/964,563

Applicant(s)

NISHIKIORI ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on May 8, 2008 is hereby acknowledged, Claims 1-13 and 17 remain pending.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2008 has been entered.

Claim Rejections - 35 USC §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, claim 1 states a process for “forming requesting condition” , “inputting requesting condition”, notifying via network”, and receiving via network” . The Examiner submits that this process constitutes merely a manipulation of data and fails to transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim 3 contains similar limitations and is rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo (US Patent 5,895,450) in view of Smith et al. (US Patent 7,346,574) and further in view of Reese (US Patent 6,236,980).

As per claim 1,

Sloo ('450) discloses a mediation negotiating method for mediating a negotiation between a client for an auction and providers of goods and/or services in the auction using an electronic network, comprising:

forming requesting conditions including a plurality of items in which priorities based on a mediating request from the client have been allocated to request purchase information in response to the mediating request of said client for the auction received via the network, wherein the forming of the requesting conditions comprises analyzing the mediating request from the client to form said plurality of items, and said plurality of items includes items formed from an inquiry to the client, items formed from client information, items calculated from values of already established request items, or a combination thereof (column 4, lines 61-67.);

forming a negotiation field; (column 4, lines 61-67)

inputting said requesting conditions;

notifying, via the network, the requesting conditions to a plurality of providers receiving, via the network, response information in accordance with said priorities from the plurality of providers who participate in said negotiation field; and
notifying, via the network, said client and the selected providers of the response information of all of the participating providers arranged in accordance with the priorities of said request purchase information; (Column 8, lines 33-58; figure 7 – steps 718-724)

Sloo ('450) does not explicitly disclose “selected in accordance with the priorities of said request purchase informations”, Reese ('980) discloses “selected in accordance with the priorities of said request purchase informations”. (Figures 6 [item 156 ranking by stars] and 16 [356 ranking indicator]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Reese ('980) method in order in order to improve the percentage of negotiations that are settled.

Sloo ('450) does not explicitly disclose "items in which priorities based on a mediating request from the client have been allocated to request purchase information in response to the mediating request of said client for the auction received via the network, wherein the forming of the requesting conditions comprises analyzing the mediating request from the client to form said plurality of items, and said plurality of items includes items formed from an inquiry to the client, items formed from client information, items calculated from values of already established request items, or a combination thereof", Smith et al. ('574)discloses "items in which priorities based on a mediating request from the client have been allocated to request purchase information in response to the mediating request of said client for the auction received via the network, wherein the forming of the requesting conditions comprises analyzing the mediating request from the client to form said plurality of items,(Column 3, lines 1-39) and said plurality of items includes items formed from an inquiry to the client, items formed from client information, items calculated from values of already established request items, or a combination thereof;(Figure 12)". It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Smith et al. ('574) method in order in order to improve the percentage of negotiations that are settled.

Official Notice is taken that "wherein the providers are not identified to the client until the client issues a negotiation finalizing instruction." is common and well known in prior art in reference to auctions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an anonymous selling system in order to prevent fraud against a specific party.

Claims 3, 12, 13 and 17 are in parallel with claim 1 and are rejected for at least the same reasons.

Claims 2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo (US Patent 5,895,450) in view of Smith et al. (US Patent 7,346,574) and further in view of Reese (US Patent 6,236,980) and further in view of Burchetta.

As per claim 2,

Sloo ('450) discloses a method according to claim 1

wherein in said forming of requesting conditions to request articles or the request purchase informations such as service, price, term of delivery, and the like, thereby forming the requesting purchase information as said requesting conditions. (Column 7, lines 66-67; column 8 lines 1-4; figure 3).

As per claim 4

Sloo ('450) discloses a method according to claim 1

Sloo ('450) does not explicitly disclose "an abstract mediating request from the client is analyzed and one or a plurality of requesting conditions are formed", Burchetta et al. ('551) discloses "an abstract mediating request from the client is analyzed and one or a plurality of requesting conditions are formed". (Column 7, lines 26-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450)

method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

As per claim 5,

Sloo ('450) discloses a method according to claim 1

Sloo ('450) does not explicitly disclose “ the request purchase information priorities in the requesting conditions inputted into said negotiation field are changed and inputted again”, Burchetta et al. ('551) discloses “ the request purchase information including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again”.(Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negations that are settled.

As per claim 6,

Sloo ('450) discloses a method according to claim 1

Wherein in said negotiation requesting step. if there are a plurality of requesting conditions, the responder is selected under a condition that he corresponds to at least one of said plurality of requesting conditions, and the negotiation field between said client is formed.(Column 8, lines 5-19).

As per claim 7,

Sloo ('450) discloses a method according to claim 1

Wherein In said negotiation requesting step, a negotiation term is set into said negotiation field and the requesting conditions are inputted,(Figure 3) and in said negotiation responding step, the end of the negotiation is discriminated and the negotiation field is closed.(Figure 7).

As per claim 8,

Sloo ('450) discloses a method according to claim 7

wherein in said negotiation responding step, the negotiation field is closed by a negotiation decision instruction of said client or an expiration of the negotiation term.(Column 8, lines 44-58).

As per claim 9,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "the negotiation term is extended on the basis of an instruction from the client", Burchetta et al. ('551) discloses "the negotiation term is extended on the basis of an instruction from the client".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 10,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 11,

Sloo ('450) discloses a method according to claim 10

Sloo ('450) does not explicitly disclose "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

Response to Arguments

The Applicants arguments filed on May 17, 2008 have been fully considered. The amended claims are rejected in view of newly discovered reference Smith et al. (US Patent 7,346,574).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685